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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,037	11/01/2001	Steve O. Rasmussen	10980546-2	3806

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EXAMINER

LIANG, LEONARD S

ART UNIT

PAPER NUMBER

2853

DATE MAILED: 01/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	Applicant(s)
10/041,037	RASMUSSEN ET AL.
Examiner	Art Unit
Leonard S Liang	2853

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on 01 November 2001.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 1-16 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-16 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 01 November 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Objections*

Claim 1 is objected to because of the following informalities: The claim states an "advancing means operable to move the guide shim from the first position to the second position once the a trailing edge of the media sheet reaches a prescribed location along the media path, the guide shim being advanced with the media sheet." This is not proper grammar. It will be construed that the claim should state "advancing means operable to move the guide shim from the first position to the second position once a trailing edge of the media sheet reaches a prescribed location along the media path, the guide shim being advanced with the media sheet." Appropriate correction is required.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-3 of U.S. Patent No. 10041037. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is disclosed in US Pat 6318854 and is covered by the patent since the patent and the application are claiming common subject matter, as shown in the below table..

<u>US Pat 6318854 CLAIMS</u>	<u># 10041037 CLAIMS</u>
<p>2. An inkjet printing apparatus which moves a media sheet along a media path and marks the media sheet with ink, comprising:</p> <ul style="list-style-type: none"><li data-bbox="295 487 812 720">(i) an inkjet printhead having a plurality of inkjet nozzles which eject ink onto a portion of the media sheet located within a print zone, the print zone located adjacent to the plurality of nozzles;</li><li data-bbox="295 741 812 882">(ii) a support which supports the media sheet as the media sheet passes along the media path through the print zone;</li><li data-bbox="295 903 812 1136">(iii) a roller located upstream along the media path prior to the print zone, the roller stabilizing the media sheet relative to a first surface during printing onto at least a first portion of the media sheet;</li><li data-bbox="295 1157 812 1495">(iv) a guide shim located along the media path, the guide shim having a guide surface extending at least from the roller, beyond the roller toward the print zone during printing, the guide shim acting upon a portion of the media sheet between the roller and the print zone to keep the media sheet out of contact with the printhead; and</li><li data-bbox="295 1516 812 1875">(v) means for advancing the guide shim along the media path toward the print zone during printing to at least a third portion of the media sheet, in which the advancing means comprises means for advancing the guide shim while a trailing edge of the media sheet moves into the print zone; and</li></ul>	<p>1. An inkjet printing apparatus which moves a media sheet along a media path and marks the media sheet with ink, comprising:</p> <ul style="list-style-type: none"><li data-bbox="931 487 1449 720">(i) an inkjet printhead having a plurality of inkjet nozzles which eject ink onto a portion of the media sheet located within a print zone, the print zone located adjacent to the plurality of nozzles;</li><li data-bbox="931 741 1449 882">(ii) a support which supports the media sheet as the media sheet passes along the media path through the print zone;</li><li data-bbox="931 903 1449 1136">(iii) a roller located upstream along the media path prior to the print zone, the roller stabilizing the media sheet relative to a first surface during printing onto at least a first portion of the media sheet;</li><li data-bbox="931 1157 1449 1495">(iv) a guide shim located along the media path, the guide shim having a guide surface extending at least from the roller, beyond the roller toward the print zone during printing, the guide shim acting upon a portion of the media sheet between the roller and the print zone to keep the media sheet out of contact with the printhead; and</li><li data-bbox="931 1516 1449 1875">(v) the guide shim capable of being advanced along the media path between a first position in which the guide shim is located upstream from the print zone along the media path and a second position in which at least a portion of the guide shim is located in the print zone; and</li></ul>

<p>(vi) having a minimum media sheet page margin corresponding to a distance from inkjet nozzles located nearest to an edge of the guide shim to an area of the guide shim located adjacent to a distal edge of the guide shim while the guide shim is in an advanced position.</p>	<p>(v) an advancing means operable to move the guide shim from the first position to the second position once a trailing edge of the media sheet reaches a prescribed location along the media path, the guide shim being advanced with the media sheet</p> <p>2. The apparatus of claim 1, in which the advancing means comprises means for advancing the guide shim into the print zone while a trailing edge of the media sheet moves into the print zone.</p>
<p>3. A method for advancing a media sheet along a media path through a print zone of an inkjet printing apparatus, the apparatus including an inkjet printhead having a plurality of inkjet nozzles which eject ink, the print zone located adjacent to the plurality of nozzles, the method comprising the steps of:</p> <p>(i) receiving the media sheet at a roller which stabilizes the media sheet along the media path relative to a first surface, the roller located upstream along the media path prior to the print zone;</p> <p>(ii) moving the media sheet under a guide shim toward the print zone, the guide shim acting upon a portion of the media sheet to maintain flatness and advance accuracy of the media sheet as a trailing edge of the media sheet travels beyond the roller toward the print zone;</p> <p>(iii) ejecting ink onto a portion of the</p>	<p>10. A method for advancing a media sheet along a media path through a print zone of an inkjet printing apparatus, the apparatus including an inkjet printhead having a plurality of inkjet nozzles which eject ink, the print zone located adjacent to the plurality of nozzles, the method comprising the steps of:</p> <p>(i) receiving the media sheet at a roller which stabilizes the media sheet along the media path relative to a first surface, the roller located upstream along the media path prior to the print zone;</p> <p>(ii) moving the media sheet under a guide shim toward the print zone, the guide shim acting upon a portion of the media sheet to maintain flatness and advance accuracy of the media sheet as a trailing edge of the media sheet travels beyond the roller toward the print zone;</p> <p>(iii) ejecting ink onto a portion of a media</p>

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<p>media sheet located within the print zone;</p> <p>(iv) advancing the guide shim along the media path toward the print zone while a trailing portion of the media sheet moves into the print zone; and</p> <p>(v) discontinuing ejection of ink onto the media sheet while leaving a media sheet margin at least as large as a minimum bottom margin, wherein the minimum bottom margin corresponds to a distance from inkjet nozzles located furthest from an edge of the guide shim to an area of the guide shim located adjacent to a distal edge of the guide shim while the guide shim is in a advanced position.</p>	<p>sheet located within the print zone;</p> <p>(iv) advancing the guide shim along the media path toward the print zone while a trailing portion of the media sheet moves into the print zone</p>
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The pending application claims the same inkjet printing apparatus and method for advancing a media sheet as the disclosed patent. The limitations of "the guide shim capable of being advanced along the media path between a first position in which the guide shim is located upstream from the print zone along the media path and a second position in which at least a portion of the guide shim is located in the print zone; and an advancing means operable to move the guide shim from the first position to the second position once a trailing edge of the media sheet reaches a prescribed location along the media path, the guide shim being advanced with the media sheet" disclosed in the instant application are naturally included in the limitations of "means for advancing the guide shim along the media path toward the print zone during printing to at least a third portion of the media sheet, in which the advancing means comprises means for advancing the guide shim while a trailing edge of the media sheet moves into the print zone; and having a minimum media sheet page margin corresponding to a distance from inkjet nozzles located nearest to an edge of the guide shim to an area of the guide shim located adjacent to a distal edge of the guide shim while the guide shim is in an advanced position."

Claims 3-9 and 11-16 depend from rejected claims 1-2 and 10.

***Response to Arguments***

Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leonard S Liang whose telephone number is (703) 305-4754. The examiner can normally be reached on 8:30-5 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier can be reached on (703) 308-4896. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

lsl LSL



Stephen D. Meier  
Primary Examiner